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10/658,808	09/08/2003	Geoffrey B. Rhoads	098888-1807	1809
99103 7590 05/03/2011 Foley & Lardner LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497				
EXAMINER				
CHEN, SHIN HON				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/658,808

**Applicant(s)**

RHOADS, GEOFFREY B.

**Examiner**

SHIN-HON CHEN

**Art Unit**

2431

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 12-21, 23-28, 37, 39, 40, 53, 56 and 58-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-21, 23-28, 37, 39, 40, 53, 56 and 58-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of Papers Received (PTO-302)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/24/11 and 3/11/11
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-40, 42, 43 and 46-59 have been examined.

**Priority**

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications, Application No. 09/476,686; 60/134,782; 09/343,104; 09/314,648; 60/134,782; 10/306,768; 09/292,569; 09/186,962; 08/649,419; 60/082,228; 09/186,962; 08/694,419; 08/637,531, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The claims disclose limitation that may be beyond scope of prior art disclosure. Furthermore, the priority information do not support all of the claims (e.g. notification of the winning of a price, displaying indication of a match, etc). Applicant is advised to contact the examiner to further discuss the issue.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-8, 12-21, 23-28, 37, 39, 40, 53, 56 and 58-64 are rejected under 35

U.S.C. 102(a) as being anticipated by Cox et al. U.S. Pat. No. 6456725 (hereinafter Cox).

5. As per claim 1, Cox discloses a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in a player device, the method comprising:

receiving digital data having the title signal via a communications connection, wherein the title data includes digital watermark comprising a first indicator, and wherein the player device includes a second indicator (Cox: column 2 lines 18-20 and column 2 lines 32-35);

detecting, at the player device, the first indicator (Cox: column 2 lines 20-21);

comparing the first indicator to the second indicator (Cox: column 2 lines 21-22);

and

performing an action based on the comparison (Cox: column 2 lines 23-24).

6. As per claim 2, Cox discloses the method of claim 1. Cox further discloses wherein the digital data is streaming audio or video data (Cox: column 9 claim 2).

7. As per claim 4, Cox discloses the method of claim 1. Cox further discloses wherein the player signal is indicative of an attribute of the device, device user, data, or data owner (Cox: column 9 claim 3).

8. As per claim 4, Cox discloses the method of claim 1. Cox further discloses decoding the digital watermarking to obtain the title signal (Cox: column 9 claim 4).

9. As per claim 5, Cox discloses the method of claim 4. Cox further discloses wherein the digital watermarking contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal (Cox: column 9 claim 5).

10. As per claim 6, Cox discloses the method of claim 1. Cox further discloses wherein the action is performed if the title signal matches the player signal (Cox: column 9 claim 8).

11. As per claim 7, Cox discloses the method of claim 6. Cox further discloses wherein the action is to inform the device user of the match and at least one consequence thereof (Cox: column 9 claim 9).

12. As per claim 8, Cox discloses the method of claim 7. Cox further discloses wherein the consequence is informing the user of the winning of a prize (Cox: column 9 claim 10).

13. As per claim 12, Cox discloses the method of claim 3. Cox further discloses wherein the player signal is indicative of a device number (Cox: column 9 claim 16).

14. As per claim 13, Cox discloses the method of claim 1. Cox further discloses in which the title signal is encoded with the digital watermarking in a time varying manner (Cox: column 9 claim 17).

15. As per claim 14, Cox discloses the method of claim 3. Cox further discloses comprising inputting the player signal to the player device prior to the act of comparing (Cox: column 10 claim 18).

16. As per claim 15, Cox discloses the method of claim 6. Cox further discloses wherein perfect matching between the title signal and player signal is necessary in order to perform the action (Cox: column 10 claim 19).

17. As per claim 16, Cox discloses the method of claim 6. Cox further discloses wherein imperfect or approximate matching between the title signal and player signal is permitted in order to perform the action (Cox: column 10 claim 20).

18. As per claim 17, Cox discloses the method of claim 6. Cox further discloses wherein the title signal and player signal contain at least two fields, each field comprising a group of bits, wherein matching of fields between the title signal and player signal is permitted in order to perform the action (Cox: column 10 claim 21).

19. As per claim 18, Cox discloses the method of claim 1. Cox further discloses wherein at least one title signal which when compared to the player signal evokes the performance of the action (Cox: column 10 claim 22).

20. As per claim 19, Cox discloses the method of claim 1. Cox further discloses wherein at least one title signal which when compared to the player signal evokes the performance of the action, is chosen to match at least one targeted demographic group (Cox: column 10 claim 23).

21. As per claim 20, Cox discloses the method of claim 1. Cox further discloses wherein the action is performed if the title signal matches the player signal and the action is to inform the device user of the match (Cox: column 10 claim 25).

22. As per claim 21, Cox discloses the method of claim 1. Cox further discloses wherein the player device comprises a personal computer and the act of transferring comprises storing the downloaded data to a recordable medium readable by the player device (Cox: column 10 claim 27).

23. As per claim 23, Cox discloses the method of claim 21. Cox further discloses wherein the acts of detecting, comparing and performing are performed after the downloaded digital data is partially stored such that the title signal is available for use in the method before the act of storing is completed (Cox: column 10 claim 29).

24. As per claim 24, Cox discloses the method of claim 1. Cox further discloses wherein the player device is a personal computer and at least the act of detecting is performed in real time as the digital data is downloaded (Cox: column 10 claim 30).

25. As per claim 25, Cox discloses a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the digital data having the title signal (Cox: column 11 claim 31);

detecting, at the personal computing device, the title signal in the data, the personal computing device comprises a configured multi-purpose electronic processor, and said act of detecting utilizes the configured multi-purpose electronic processor (Cox: column 11 claim 31);

comparing the title signal to the player signal (Cox: column 11 claim 31); and

performing an action based upon the comparison, in which the player signal expires after a predetermined time such that it is no longer useful for comparison to the title signal (Cox: column 12 claim 53).



26. As per claim 26-28 and 37, 26- 28 and 37 encompass the same scope as claims 1-8, 12-21 and 23-24. Therefore, claims 26- 28 and 37 are rejected based on the same reason set forth above in rejecting claims 1-8, 12-21 and 23-24.

27. As per claim 39. (Currently Amended) A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the computer readable set of instructions having the title signal, in which the computer readable set of instructions represents an application program executable by the personal computing device;

detecting the title signal in the computer readable set of instructions, in which the personal computing device comprises a software operating system for launching the application program, and wherein the act of detecting is performed by the software operating system operating on a multi-purpose electronic processor;

comparing the title signal to the player signal; and

performing an action based upon the comparison (Cox: column 11 claims 38 and 50).

28. As per claim 40, Cox discloses the method of claim 39. Cox further discloses wherein the operating system also performs the acts of comparing and performing (Cox: column 11 claim 51).

29. As per claim 42, Cox discloses the method of claim 25. Cox further discloses further comprising updating the player signal for comparison to the title signal (Cox: column 12 claim 54).

30. As per claim 39, 40, 53, 56, 58-54, 39, 40, 53, 56, 58-54 encompass the same scope as previous pending claims. Therefore, claim 39, 40, 53, 56, 58-54, 39, 40, 53, 56, 58-54 are rejected based on the same reason set forth above in rejecting above claims.

### **Claim Rejections - 35 USC § 102**

31. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

32. Claims 1-8, 12-21, 23-28, 37, 39, 40, 53, 56 and 58-64 are rejected under 35 U.S.C. 102 (g) based upon claims 1-67 of Patent No. 6456725.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

### **Response to Arguments**

33. Applicant's arguments filed on 2/18/11 have been fully considered but they are not persuasive.

Regarding the amendment filed on 2/18/11, applicant has amended the claims to provide support for priority. However, the amendment has changed the scope of the claims and it may be proper to subject the application to interference proceedings especially when the claim language resembles that of prior art.

### **Conclusion**

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIN-HON CHEN whose telephone number is (571)272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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